

doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 and 10-16 of copending application Serial No. 07/957,598. Furthermore, claim 21 was rejected under 35 U.S.C. §102(b) as being anticipated by Forsberg, U.S. Patent No. 4,914,876 (hereinafter "Forsberg"). Claims 1-5, 7-11, 13-15 and 21 were also rejected under 35 U.S.C. §103 as being unpatentable over Forsberg in view of Italy 709,599 (hereinafter "Italy '599"). The Examiner also objected to the specification and rejected claim 12 under 35 U.S.C. §112, first paragraph, for failing to provide an adequate written description of the invention.

Applicant respectfully traverses each of the Examiner's rejections to the extent that they are maintained.

Applicant has now amended claims 1, 6-9 and 21 and has cancelled claims 16-20 without prejudice. Applicant hereby reserves the right to refile the cancelled claims in a future application. Applicant has also added new claims 22-34, which are directed to various features disclosed in the specification. Further, Applicant has amended the specification at several points to further harmonize the terminology used in the specification and the claims. In addition, Applicant has submitted a proposed drawing change to Figure 1 to correct an incorrect reference character found by the Applicant.

Applicant respectfully submits that none of the above amendments add new matter as the subject matter of the amendments is fully supported in the specification, claims and drawing as

originally filed. Applicant will first address the formal matters raised by the Examiner. In addition, Applicant will defer a discussion of the provisional double patenting rejection until after a discussion of the art-based rejections.

#### Restriction Requirement

In the subject Office Action, the Examiner first subjected the claims to a restriction requirement and requested Applicant to affirm the election of claims 1-15 and 21. Applicant hereby affirms this election.

#### § 112 Matters

In the subject Office Action, the Examiner objected to the specification, and rejected claim 12, under 35 U.S.C. § 112, first paragraph. In particular, the Examiner indicated that the claimed matrix comprising tie backs positioned between the blocks of the upper and lower courses was not described in the specification nor shown in the figures.

In response, Applicant respectfully directs the Examiner's attention to page 13, lines 1-6 of the specification, which discuss the use of tie backs in conjunction with the protrusions and insets to secure the retaining wall against fill. Applicant also directs the Examiner's attention to U.S. Patent No. 5,062,610 which has been incorporated by reference in the present application. In this referenced patent, tie backs and set back are disclosed in great detail (see, in particular, figure 9).

Applicant respectfully submits that the specification as originally filed provides an adequate written description of the claimed features of the invention. Reconsideration by the Examiner is therefore respectfully requested.

#### Art-Based Rejections

Next, in the subject Office Action, claims 1-5, 7-11, 13-15 and 21 were rejected under 35 U.S.C. §103 as being unpatentable over Forsberg in view of Italy '599. In addition, claim 21 was rejected under 35 U.S.C. §102(b) as being anticipated by Forsberg. The Examiner did indicate, however, that claim 6 would be allowable if amended to include all of the limitations of the base claim and any intervening claims.

First, regarding claim 6, Applicant has amended this claim to place the claim in independent form, to correct several minor grammatical errors in the claim, and to recite that the block legs have front surfaces which extend toward the block front surface. As this claim was previously objected to by the Examiner, Applicant respectfully requests consideration and allowance of this claim.

Second, regarding independent claim 21, the Examiner has rejected this claim as being anticipated by Forsberg. In particular, the Examiner has asserted that Forsberg teaches a method of building a retaining structure having blocks of an upper course shorter in front to rear surface dimension than the blocks of a lower course.

Claim 21 recites that each side surface of a block has an inset extending inward and spanning from the top to the bottom surface of the block. Further, the top surface includes at least one protrusion positioned adjacent the insets on the top surface for mating with an inset on another block.

Forsberg does not disclose insets extending inward from the side surfaces and spanning from the top surface to the bottom surface. Consequently, claim 21 is novel over Forsberg. Also, there is no disclosure or suggestion in Forsberg for Applicant's recited insets. Therefore, claim 21 is also non-obvious. Reconsideration and allowance of claim 21 is therefore respectfully requested.

Third, regarding independent claims 1 and 8, the Examiner has rejected these claims as being unpatentable over Forsberg in view of Italy '599. The Examiner has asserted that Forsberg teaches a composite masonry block having legs which angle toward a front surface of the block. The Examiner, however, has admitted that Forsberg lacks insets on the side surfaces spanning from the top surface to the bottom surface. Instead, the Examiner relies on Italy '599 for teaching insets located on side surfaces of a block.

Claim 1, which is exemplary, recites a composite masonry block wherein first and second legs on the block include "front surfaces which angle towards said block front surface as said front surfaces extend away from said block back surface." As discussed throughout the specification (e.g., at pages 16-17),

Applicant's claimed forward-angled leg front surfaces provide several unexpected advantages in use and manufacture.

Applicant respectfully submits that neither reference, alone or in combination, discloses or suggests this claimed feature of Applicant's invention.

Forsberg teaches a block having first and second legs extending from a back surface of the block. The legs have back surfaces which curve toward the front surface of the block. However, the front surfaces of the legs (i.e., the surfaces facing the front of the block) angle away from the front surface of the block as they extend from the back surface of the block, which is precisely opposite to Applicant's claimed structure.

Similarly, the blocks disclosed in Italy '599 do not include any structure which is analogous to legs extending from a back surface, and in particular, no structure is disclosed or suggested which angles toward the front surface of the block. Therefore, this reference does not add anything to the Examiner's rejection. A translation of Italy '599 is enclosed to facilitate the Examiner's understanding of the reference.

As neither reference, alone or in combination, discloses or suggests Applicant's invention recited in independent claims 1 and 8, these claims are patentable over the prior art of record. Accordingly, reconsideration and allowance of claims 1 and 8, as well as claims 2-5, 7, 9-15 and new claims 22-34 which depend therefrom, is respectfully requested.

### Provisional Double Patenting Rejection

The Examiner also provisionally rejected claims 1-5 and 8-15 under the judicially-created doctrine of obviousness type double patenting as being unpatentable over claims 1-5 and 10-16 of copending application Serial No. 07/957,598. It was the Examiner's opinion that the claims of the instant application were not patentably distinct from the prior application because the only differences, forward-angling legs and retaining walls built from different-sized blocks, were shown in Forsberg.

Applicant respectfully traverses the provisional rejection on the ground that the claimed feature of forward-angled leg front surfaces is not disclosed or suggested by Forsberg, as discussed above in the preceding section. Moreover, this feature is not disclosed or suggested in the prior copending application. As such, independent claims 1 and 8 are not merely obvious variations of the claims in the prior copending application. Thus, a double patenting rejection of claims 1-5 and 8-15 would not be proper in this case.

### Conclusion

As Applicant's claims are directed to an invention which is novel and non-obvious over the references cited by the Examiner, consideration and allowance of all pending claims is respectfully requested. If the Examiner has any questions regarding this amendment and response, or which might otherwise further this

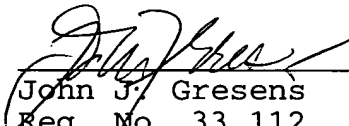
case onto allowance, the Examiner is respectfully directed to contact Applicant's attorney, John J. Gresens at 612-298-1055.

Respectfully submitted,

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By his attorneys,

10/17/94  
Date

  
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Enclosures:      Proposed Correction to Figure 1  
                    Translation of Italy '599

